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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,965	07/24/2003	Paul DiCesare	896P011379-US (PAR)	1641

7590 06/02/2009
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EXAMINER

SICA, VINCENT C

ART UNIT	PAPER NUMBER
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3739

MAIL DATE	DELIVERY MODE
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06/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/625,965	Applicant(s) DICESARE ET AL.	
	Examiner VINCENT SICA	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 7-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In response to the amendment filed 04/09/08, claims 1-11 are pending, with claims 3 and 7-11 withdrawn from consideration.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "a medical device having a device operation effector" in the preamble and the limitation "a common operation effector of the medical device" (lines 13-14). It is unclear if these operation effectors are the same or if there are two separate operation effectors of the medical device.

Claims 2 and 4-6 are also rejected for incorporating the above error through dependency.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferzli (5,147,373).

Regarding claim 1, Ferzli discloses a manual actuating apparatus for operating a medical device having a device operation effector for operation of the medical device comprising: a handle (Figs 1 and 17); a finger loop (finger grip 16) mounted on the handle for receiving a finger of an operator; first (18) and second (20) lever members mounted on the handle for grasping engagement by other fingers of the operator (column 2 lines 43-49), each of the first and second lever members being independently and pivotably (pivots 22 and 24) mounted on the handle for movement between respective first and second positions; and a force transmitting member (actuating rod 30) operably connecting at least one of the finger loop and the first and second lever members to a common operation effector (comprising the distal end of the device, which includes first and second jaws, see Fig. 1 reproduced below) of the medical device for operating the common operation effector at a location distant from the handle where movement of the first and second lever members between the first and second positions, relative to the finger loop, causes movement of the common operation effector for performing a common operation of the medical device (i.e. a clamping of jaws of the common operation effector); whereby, in the course of operating the common operation effector, the first and second lever members are positioned relative to the finger loop so that the operator can reposition the other fingers between the first and second lever members with rotation of the finger within the finger loop while operating the common operation effector with the finger within the finger loop and

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thereby assure a comfortable hand posture throughout the complete range of operation of the medical device (column 3 lines 43-45).

common operation
effector



It is noted that the limitation "where movement of the first and second lever members between the first and second positions, relative to the finger loop, causes movement of the common operation effector for performing a common operation of the medical device" as recited in lines 15-18 of the claim is broad enough to include the operation of the medical device as disclosed by Ferzli. Movement of the first lever member and movement of the second lever member in the Ferzli device both cause actuation of jaw members at the distal end of the device, which is movement of the common operation effector for performing a common operation (jaw closure) of the medical device.

Regarding claim 4, Ferzli discloses an upper finger loop (18) is integral with the first lever member at the free end thereof; and wherein a front finger loop (20) is integral with the second lever member at the free end thereof (Fig 1).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Bacher (6,299,625)

Regarding claim 1, Bacher discloses a manual actuating apparatus in Figs. 1, 6 and 7 for operating a medical device having a device operation effector for effecting operation of the medical device comprising: a handle (28); a finger loop (38) mounted on the handle for receiving a finger of an operator; first and second lever members (30, 32) mounted on the handle for grasping engagement by other fingers of the operator, each of the first and second lever members being independently and pivotably mounted on the handle for movement between respective first and second positions (col. 8, lines 39-41); and a force transmitting member (108, shown in Fig. 6) operably connecting at least one of the finger loop and the first and second lever members (col. 11, lines 40-44) to a common operation effector (jaws 14, 16) of the medical device for operating the common operation effector at a location distant from the handle, where movement of the first and second lever members between the first and second positions, relative to the finger loop, causes movement of the common operation effector for performing a common operation (i.e., clamping) of the medical device (col. 8, line 62 – col. 9, line 3); whereby, in the course of operating the common operation effector, the first and second lever members are positioned relative to the finger loop so that the operator can reposition the other fingers between the first and second lever members with rotation of

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the finger within the finger loop while operating the common operation effector with the finger within the finger loop and thereby assure a comfortable hand posture throughout the complete range of operation of the medical device (col. 9, lines 30-40).

Regarding claim 1, Bacher discloses an upper (82, depending on orientation of the device) finger loop is integral with the first lever member at the free end thereof; and wherein a front (84) finger loop is integral with the second lever member at the free end thereof in Fig. 5.

Allowable Subject Matter

8. Claims 2, 5 and 6 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments regarding claim 1 have been fully considered but they are not persuasive. Applicant argues: "Ferzli simply does not disclose that the finger grips (20, 18) are connected to a 'common operation effector' as each of the jaws (14, 20) are separately connected to their respect finger grip (20, 18)." Initially, the examiner notes that the term "common operation effector" is a broad term which provides no structural details regarding the effector itself. Therefore, this term can be interpreted in multiple fashions and is not limited to a single jaw structure. The distal portion of the Ferzli device which includes both jaws 12 and 14 has been considered the "common

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operation effector" as shown in Fig. 1 reproduced above. This effector, including jaws 12 and 14, performs a common operation (i.e., clamping) with two different jaws. Thus, while each finger grip (20, 18) in Ferzli independently opens and closes separate jaws (12, 14) respectively, movement of each finger grip between first and second positions, relative to the finger loop, causes movement of the common operation effector (i.e., clamping of either jaw) for performing a common operation (i.e., clamping) of the medical device, as recited in Applicant's claim 1.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VINCENT SICA whose telephone number is (571)270-5531. The examiner can normally be reached on 7:30AM to 5:00PM EST Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571)272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vincent Sica/
05/29/09

/Michael Peffley/
Primary Examiner, Art Unit 3739